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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/937,583
Filing Date: January 18, 2002
Appellant(s): DECAUX ET AL.

James R. Yee
For Appellant

EXAMINER'S ANSWER

MAILED
DEC 02 2004
GROUP 1700

This is in response to the appeal brief filed 4-13-04.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Brief includes a statement that claims 1-13 are grouped to stand or fall together.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

| | | |
|--------------|-----------------------------|---------|
| GB 1,083,203 | Precision Mecanique Labinal | 9-1967 |
| US 5,904,845 | Girondi | 5-1999 |
| US 5,382,361 | Brun | 1-1995 |
| US 4,683,055 | Bosch et al | 7-1987 |
| US 5,685,278 | Bradford et al | 11-1997 |
| US 3,813,034 | Lewis et al | 5-1974 |

(10) *Grounds of Rejection*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1,083,203 in view of Girondi.

With respect to claim 1, '203 discloses a filter body having opposing body filter ends 1, 16, the filter body having an interior chamber within which a filter medium 7 is located, the filter medium including a filter member having a first end secured to a support plate (e.g., element 12, which supports the filter media 7 to which it is adhesively bonded to) and a second end secured to the filter body 1, the filter body being multi-pad construction, the first and second ends being secured such that fuel can only flow from the outer periphery of the filter medium to an inner part of the filter

medium by flowing through the filter medium, the pads being non-removably, sealingly secured to one another such that the pads form an integral whole, the filter body being shaped to define an inlet port 6 and an outlet port 5 communicating with dirty and clean sides of the filter medium, both the inlet and outlet pods being positioned at the same body end of the filter body. '203 fails to specify the support plate as having an outer periphery which engages the inner surface of the filter body. Girondi discloses an analogous filter that includes a support plate 22 that is obviously disposed in contact with an inner surface of a filter body 10 since the only flow between chambers 31 and 33 is through the flow apertures 22a (see FIGS. 1 and 3), and suggests that such a member functions as a baffle to maintain heavier contaminants within chamber 33 positioned adjacently below the support plate. It would have been obvious to have modified the filter member of '203 so as to have included a support plate having an outer periphery in engagement with the inner surface of the filter body as suggested by Girondi in order to maintain heavier contaminants within a chamber adjacently below the support plate.

As to claim 2, '203 discloses the pads 1, 16 of the filter body as being secured to one another by means of a friction welding technique (see lines 25-28 of page 2).

Concerning claim 4, 1203 discloses the second end of the filter member as being directly bonded to the filter body (e.g., via adhesive 10).

Claims 3 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1,083,203 in view of Girondi as applied to claim 1 above, and further in view of

Brun.

With respect to claim 3, '203 fails to specify the filter medium as being a pleated paper filter member. Brun discloses an analogous filter including a pleated filter paper member 14B (see FIG. 3 and lines 10-13 of col. 4) and suggests that such a filter medium is useful for filtering liquids. It would have been obvious to have modified the '203 filter so as to have included a pleated paper filter member as suggested by Brun in order to provide a filter member capable of filtering liquids.

Concerning claim 11, '203 fails to disclose a downwardly depending tubular member secured to the filter body serving to force fuel to flow in a downward direction prior to entering the tubular member. Brun discloses a downwardly depending tubular member 13B secured to the filter body serving to force fuel to flow in a downward direction prior to entering the tubular member and suggests that such an arrangement enables air to be controllably bled from a dead space within the filter member. It would have been obvious to have modified the '203 filter so as to have included a tube as suggested by Brun in order to enable air to be bled from a dead air space within the filter member.

As to claim 12, Brun discloses the tubular member as having one or more openings 19 through which air is able to flow at a relatively low rate.

Regarding claim 13, '203 discloses the second end of the filter as being bonded directly to the filter body 1.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over

GB 1,083,203 in view of Girondi as applied to claim 1 above, and further in view of Bosch et al.

With respect to claim 5, '203 fails to specify the recited second inlet and outlet port. Bosch et al include a second inlet and outlet port 28, 29 and suggests that such an arrangement enables the introduction of warmed fuel into the filter to melt wax crystals in cold fuel. It would have been obvious to have modified the '203 device so as to have included second inlet and outlet ports as suggested by Bosch et al in order to enable the introduction of warm fuel into the filter.

As to claim 6, .203 discloses a temperature sensitive valve 33, 34.

Claims 5-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1,083,203 in view of Girondi as applied to claim 1 above, and further in view of Bradford et al.

With respect to claim 5, 1203 fails to specify the recited second inlet and outlet port. Bradford et al include a second inlet and outlet pod 29 and 30 (see FIG. 3) and suggests that such an arrangement enables the introduction of warmed fuel into the filter to melt wax crystals in cold fuel. It would have been obvious to have modified the \$203 device so as to have included second inlet and outlet pods as suggested by Bradford et al in order to enable the introduction of warm fuel into the filter.

As to claim 6, f203 discloses a temperature sensitive valve 38.

As to claim 7, Bradford et al discloses a pressure sensitive valve 38 that includes a ball valve 33.

Concerning claim 9, Bradford et al disclose a non return valve 33 resiliently biased into engagement with a seating.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1,083,203 in view Girondi and Bosch et al or Bradford et al as applied to claim 6 above, and further in view of Lewis et al .

With respect to claims 7-8, 1203, Bosch et al, and Bradford et al fail to specify a ball valve movable under the influence of a bimetallic element. Lewis et al discloses that ball valves movable under the influence of a bimetallic element are known in the art and suggests that such a valve provides a reliable seal. It would have been obvious to have modified the combination suggested by .203, Bosch et al, or Bradford et al so as to have included a ball valve as suggested by Lewis et al in order to provide a secure seal.

Concerning claim 9, Bradford et al disclose a non-return valve 33 resiliently biased into engagement with a seating.

(11) *Response to Argument*

Applicant argues on page 5 of the brief that the prior art does not show a filter medium having a plate with an outer periphery which engages an inner surface of the filter body as recited in instant claim 1, however, as explained in the final rejection listed above, it is held that Girondi discloses a filter medium 20 having a support plate 22 that is obviously disposed in contact with an inner surface of a filter body 10 since the only

disclosed flow between chambers 31 and 33 is through the flow apertures 22a (see FIGS. 1 and 3).

Applicant argues further on page 5 of the brief that no motivation has been shown by the examiner to modify the plate of the British '203 reference to include a filter member that engages the filter body, however, as stated in the final rejection listed above, it is held that it would have been obvious to have modified the filter member of '203 so as to have included a support plate having an outer periphery in engagement with the inner surface of the filter body as suggested by Girondi in order to maintain heavier contaminants within a chamber adjacently below the support plate.

Applicant's arguments on pages 6 and 8 of the brief that FIGS. 1 and 3 of Girondi show a gap between the outer periphery of the plate 22 and an inner surface of the filter body is noted, however, it is held that the drawings cannot be relied upon to correctly illustrate a gap since Girondi fails to teach that the patent drawings are to scale (see *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 22 F.3d 951, 956, 55 USPQ2d 1487, 1491 (FED Cir. 2000) and M.P.E.P. 2125). Accordingly, it is held that the gap shown in FIGS. 1 and 3 of Girondi constitutes an artifact and cannot be relied upon to show that there is no engagement between the outer periphery of the plate 22 and an interior surface of the filter body or housing 10.

Applicant argues on page 6 and 8 of the brief that there is no statement in Girondi that the apertures 22a in the plate 22 provide the only flow between the chambers 31 and 33, however such a holding is not considered to be entirely correct since lines 41-43 of col. 2 of Girondi state that "The lower disc 22 has apertures 22a in

its periphery to provide free passage between the first chamber 31 and the third chamber 33." of which constitutes the only teaching regarding flow between the chambers 31 and 33. Accordingly, it is held that one skilled in the art would ascertain that no flow would occur between the outer periphery of the plate 22 and the filter body 10 of Girondi since the only disclosed flow between chambers 31 and 33 occurs through the apertures 22a and because no flow between the outer periphery of the plate and the filter body is expressly disclosed in the reference.

Applicant argues on page 7 of the brief that the rejections of claims 2-13 should be withdrawn since the rejection of claim 1 is improper and because claims 2-13 ultimately depend from claim 1, however, the rejections of claims 2-13 are being maintained since the rejection of claim 1 considered to be proper for the reasons given above. Accordingly, claims 1-13 are grouped such that claims 2-13 stand or fall together with claim 1.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,
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mos
November 30, 2004

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